



AP-2

Applicant: Kevin L. Parsons  
Serial No.: 10/625,020  
Filed: 23 JULY 2003  
TITLE: TACTICAL DEFENSE DEVICE HAVING BATON  
AND SPRAY DISPENSING CAPABILITIES  
Confirmation No. 8420  
Docket No. 8342/89199

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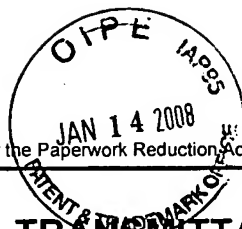
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	Filing Date	23 July 2003	
	First Named Inventor	Kevin L. PARSONS	
	Art Unit	3711	
	Examiner Name	William M. Pierce	
Total Number of Pages in This Submission	6	Attorney Docket Number	8342/89199

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<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	Tactical Defense Device Having Baton And Spray Dispensing Capabilities.	
	CONFIRMATION NO. 8420	

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Firm Name	Welsh & Katz, Ltd.		
Signature			
Printed name	L. Friedman		
Date	10 JANUARY 2008	Reg. No.	37,135

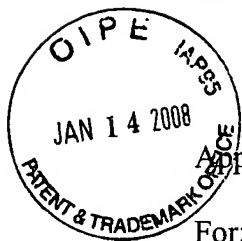
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8342/89199



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Kevin L. PARSONS )  
)  
For: TACTICAL DEFENSE DEVICE )  
HAVING BATON AND SPRAY )  
DISPENSING CAPABILITIES )  
)  
Ser. No.: 10/625,020 )  
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Filed: 23 July 2003 )  
)  
Art Unit: 3711 )  
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Primary Examiner: William M. Pierce )  
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**APPELLANT'S REPLY BRIEF ON APPEAL**

Mail Stop Appeal Brief-Patents  
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Dear Sir or Madam:

This is a reply to the Examiner's Answer mailed 13 December 2007.

1. **Claim 55 satisfies the requirement of the second paragraph of 35 U.S.C. §112.**

The Examiner's Answer persists in maintaining a rejection of claim 55 based on alleged indefiniteness, apparently because claim 55 may read on some embodiments that are not disclosed. However, a claim is not indefinite if one skilled in the art can determine without difficulty whether the claim reads on a particular collection of components. *Application of Venezia*, 530 F.2d 956, 959, 189 USPQ 149, 152 (CCPA 1976) (cited in Final Office Action). With respect to the rejection of claim 55, no reason is presented why anyone would have any difficulty in determining whether depressing a cap will mechanically cause actuator movement as recited in claim 55. The rejection is not supported and is not justified.

2. **Claim 55 is enabled.**

The Examiner's Answer raises the new rejection of lack of enablement, that was anticipated and addressed on page 22 of the 8 January 2007 reply to an earlier office action. Relying on MPEP §2164.08(c) and *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976), the new rejection erroneously asserts that claim 55 is not enabled because it allegedly fails to recite a "critical feature." Without any support and without any specific citation to the specification, the rejection erroneously asserts that the actuator button is "a critical feature to [appellant's] invention and to the operability of his device." However, MPEP §2164.08(c) states that

an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

There is no language in the captioned application indicating that an actuator button (such as actuator button 78 in a disclosed embodiment) is critical. In addition, the abstract does not mention an actuator button, and the summary of the invention (¶¶9-16) does not mention an actuator button. This totally undermines the argument of criticality.

The bottom of page 8 of the Examiner's Answer erroneously asserts that "one skilled in the art would be left blank to figure out how to move the actuator [absent an actuator button]," and then immediately lists some examples of how to do it! One of ordinary skill in the art will be at least as resourceful as the Examiner in using the disclosure of the captioned application to make and use embodiments of claim 55 that do not include an actuator button. Of course, the real thinking underlying the rejection is that embodiments without an actuator button are not expressly disclosed. However, "not everything necessary to practice the invention need be disclosed.... All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art." MPEP §2164.08.

Even in *Mayhew* (cited in support of the rejection), some missing limitations were critical and others were not. A cooling zone at a point where an alloy coated steel strip left a spelter bath was critical because the specification expressly stated that the invention was "practicable because of special cooling apparatus, specially located." 527 F.2d at 1233, 188 USPQ at 358. However, other limitations such as the temperature of the cooling zone were not critical, and a lack of enablement rejection of claims that did not recite those other limitations was reversed. *Id.* at 1233-34, 188 USPQ at 358-60. With respect to claim 55 of the captioned application, the Examiner's Answer itself

demonstrates that an actuator button is not “critical,” and claim 55 is enabled regardless of whether it reads on embodiments that were not expressly disclosed.

3. **The DeLucia sleeve is not slidingly insertable.**

The DeLucia sleeve 46 is *not* slidingly insertable, as recited by claim 75. The Examiner’s Answer first argues that the DeLucia propellant capsule 44 is slidingly insertable. However, claim 75 recites the sleeve (and not necessarily the pressurized spray cartridge) being slidingly insertable.

The Examiner’s Answer next argues that DeLucia sleeve 46 must have been slid into chamber 34 during assembly (i.e., before sleeve 46 was “fixed to the housing 14 by rivet means 48,” DeLucia 2:40-42). Regardless of whether this accurately reflects the assembly of the DeLucia device, this argument distorts the claim language to mean exactly the opposite of what it says. This is like asserting that a fixed component satisfies a claim requirement to be adjustable, because it had to be adjusted into the correct position before it was fixed.

Finally, the Examiner’s Answer quotes from ¶44 of the specification about diameter limitations for a sleeve to be sliding insertable. Such sizing may be necessary but it is not sufficient. The DeLucia sleeve 46 is narrow enough, but it is riveted in place and is *not* slidingly insertable.

4. **The DeLucia lens 25 does not satisfy nozzle plate limitations.**

The Examiner’s Answer now identifies the DeLucia lens 25 as corresponding to the nozzle plate of claim 91, and DeLucia orifice 66 as corresponding to the discharge orifice of claim 91. It asserts that the DeLucia lens 25 is “in the forward portion 17 that ‘defines’ the orifice 66.” However, claim 91 recites not only that the nozzle plate is

supported within the forward portion of the dispenser, but that the nozzle plate itself defines the discharge orifice. The same is true of claims 84 and 85 and, of course, of claims 101 and 102 that depend from claim 91. The DeLucia lens 25 does not define orifice 66. DeLucia Figure 1 shows that orifice 66 is in discharge tube 68 (DeLucia 2:63), and is not touched by and is not defined by the flashlight lens 25. To the extent that the DeLucia lens 25 were removed or that a different lens 25 were substituted, orifice 66 and the tube 68 that defines orifice 66 would remain untouched and exactly the same. DeLucia lens 25 does not define orifice 66 and cannot correspond with the claimed nozzle plate. This alone renders the references insufficient.

An independent reason why the references are insufficient is that claim 91 also expressly recites that the appearances of the outer surfaces of the different interchangeable nozzle plates are “designed respectively to conceal or to reveal the chemical dispersing use of the device.” This is not a limitation of intent as asserted by the Examiner’s Answer. This is an express claim requirement regarding the appearances of the outer surfaces of the different interchangeable nozzle plates. Whether the DeLucia lens 25 is capable of being replaced by a different flashlight lens is not sufficient. The point is not merely, as stated in the Examiner’s Answer, that DeLucia would have a different reason for interchanging its flashlight lens than the appellant has for interchanging nozzle plates. Unlike the circumstances in *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) cited by the Examiner’s Answer, DeLucia does not disclose what is claimed. It does not disclose a lens 25 with an outer surface designed to reveal the chemical dispersing use of the device. In addition, since lens 25 is a flashlight lens, DeLucia also teaches away from a lens 25 with an opaque surface that would reveal

that the device is something other than merely a flashlight. A lens 25 with an opaque surface would prevent the DeLucia device from being used as a flashlight the way it is supposed to function.

5. **DeLucia does not disclose a guide pin.**


The Examiner's Answer asserts that any element of a prior art device may be chosen in determining whether claim 78 reads on that device. However, the same element has to be chosen consistently from one limitation to the next for the same claim. On page 5 of the Examiner's Answer, the DeLucia slide block 130 is characterized as the claimed actuator for claim 78. However, on pages 11-12 of the Examiner's Answer, slide block 130 is characterized as the claimed actuator button with plunger 124 being characterized as the claimed guide pin for guiding movement of the actuator button. With that characterization, the claimed actuator is not disclosed. If plunger 124 is characterized as the claimed actuator button, then the claimed guide pin for guiding movement of the actuator button is not disclosed. One end of optic rod 138 moves up and down with the top of plunger 124, but does not guide the movement of plunger 124 and is not the claimed guide pin.

For the foregoing reasons and those discussed in Appellant's initial brief, favorable consideration of this Appeal and allowance of the captioned application are respectfully requested.

10 January 2008

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Respectfully submitted,

  
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